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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Fleming

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,815	Applicant(s) FLEMING ET AL.	
	Examiner Susanna M. Diaz	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final Office action is responsive to Applicant's response to the requirement for information under 37 CFR 1.105.

Claims 1-54 are presented for examination.

Response to Arguments

2. All previously presented arguments with respect to claims 1-54 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-33 and 47-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of system claims is defined by structural elements and their corresponding functionality. In system claims 12-22 and 47-50, it is not clear which structural elements are attributed to certain features of the claims, such as the "events broker," the "event service," and the "events check timer," thereby rendering the metes and bounds of these terms (and the claims as whole) vague and indefinite. Applicant is reminded that humans cannot be claimed as system elements. Also, software must be tied into the structural elements of a system claim in order to clearly be incorporated within the scope of the claim as a whole.

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For example, software should be stored in a memory device of the system and be executable by a processing element of the system.

The preambles of dependent claims 13-22 and 47-50 make reference to "the event server" of the claim from which each depends. Since "the event server" is only one element of the system of independent claim 12, it should be clarified that the dependent claims are directed toward "the event server system" of the claim from which each depends.

Claims 23-33 and 51-54 are directed toward computer-readable instructions that are read and executed by a computer; however, the computer-readable instructions are not embodied in a static medium. Without the proper medium, the computer-readable and computer-executable instructions are functional descriptive material *per se*, which is an improper article of manufacture claim format.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4, 11, 23-33, 43-46, and 51-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Comiskey explains that mental processes *per se* are not statutory under § 101. Mental processes must be tied into some other category of statutory subject matter in order to be potentially patentable under § 101. *Comiskey*

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specifically states, "However, mental processes -- or processes of human thinking -- standing alone are not patentable even if they have practical application." (See *In re Comiskey*, 84 USPQ2d, at 1678) *Comiskey* continues with the rationale that "the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable." (See *In re Comiskey*, 84 USPQ2d, at 1679) Claims 1-4, 11, and 43-46 are directed toward a mental process that is totally reliant on the operation of human intelligence alone and the process recited in these claims is not tied to another statutory class nor does it transform underlying subject matter to a different state or thing; therefore, claims 1-4, 11, and 43-46 do not fall into one of the statutory categories recognized as patentable under 35 U.S.C. § 101.

Claims 23-33 and 51-54 are directed toward computer-readable instructions that are read and executed by a computer; however, the computer-readable instructions are not embodied in a static medium. Without the proper medium, the computer-readable and computer-executable instructions are functional descriptive material *per se*, which is not statutory under § 101.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-54 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

By Applicant's own admission in the response to request for information (filed October 14, 2007), "the Claimed Inventions were, to the best of the co-inventors knowledge, first implemented in BEA WebLogic Enterprise 5.0" (page 3 of Applicant's response). Applicant has submitted the press release entitled "BEA WebLogic Enterprise 5.0 Adds EJB to Power-Packed E-Commerce Arsenal," which describes various features of this product. The press release itself is dated December 6, 1999, which is more than one year prior to Applicant's critical priority date of December 12, 2000. Although this press release states that BEA WebLogic Enterprise 5.0 will be available beginning December 22, 1999, the Examiner proffers the article, "BEA Announces Product Strategy to Bridge the Gap Between E-Generation Expectations and E-Business Performance." This article was published on December 6, 1999 and it states, "As part of the rollout, each division today announced roadmaps for its products, with the E-Commerce Server Division debuting its newest product, BEA WebLogic Enterprise 5.0, at today's symposium (please see separate press release) and

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the E-Commerce Services Division making its enhanced portfolio of consulting services available immediately. ”

MPEP § 2133.02 states:

“Any invention described in a printed publication more than one year prior to the date of a patent application is prior art under Section 102(b), even if the printed publication was authored by the patent applicant.” *De Graffenried v. United States*, 16 USPQ2d 1321, 1330 n.7 (Cl. Ct. 1990). “Once an inventor has decided to lift the veil of secrecy from his [or her] work, he [or she] must choose between the protection of a federal patent, or the dedication of his [or her] idea to the public at large.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 9 USPQ2d 1847, 1851 (1989).

Regarding the issue of public use under 35 U.S.C. § 102(b), the MPEP continues to explain the following:

2133.03(a) [R-5] “Public Use”

I. **> TEST FOR “PUBLIC USE”

The public use bar under 35 U.S.C. 102(b) arises where the invention is in public use before the critical date and is ready for patenting. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 76 USPQ2d 1741 (Fed. Cir. 2005). As explained by the court,

The proper test for the public use prong of the § 102 (b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Commercial exploitation is a clear indication of public use, but it likely requires more than, for example, a secret offer for sale. Thus, the test for the public use prong includes the consideration of evidence relevant to experimentation, as well as, inter alia, the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial

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exploitation.... That evidence is relevant to discern whether the use was a public use that could raise a bar to patentability, but it is distinct from evidence relevant to the ready for patenting component of *Pfaff's* two-part test, another necessary requirement of a public use bar *Id.* at 1380, 76 USPQ2d at 1744 (citations omitted). See MPEP § 2133.03(c) for a discussion of the "ready for patenting" prong of the public use and on sale statutory bars.<

"[T]o constitute the public use of an invention it is not necessary that more than one of the patent articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well defined case of such use is just as effectual to annul the patent as many." Likewise, it is not necessary that more than one person use the invention. *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

As seen in the press release submitted by Applicant and the article, "BEA Announces Product Strategy to Bridge the Gap Between E-Generation Expectations and E-Business Performance," BEA WebLogic Enterprise 5.0 was (1) was accessible to the public or (2) was commercially exploited more than one year prior to Applicant's earliest priority date of December 12, 2000. BEA WebLogic Enterprise 5.0 was debuted at a symposium on December 6, 1999 (i.e., it was accessible to the public) and, also on December 6, 1999, the public was informed about its features as well as the fact that it would be made available for sale on December 22, 1999. While this product did not formally go on sale to the public until just after Applicant's critical date of December 12, 1999, there was commercial exploitation of the product as early as December 6, 1999 since public interest in the product was spurred in anticipation of the formal

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release of the completed, operational product, which was publicly debuted at a symposium on the same day (December 6, 1999).

Applicant's product BEA WebLogic Enterprise 5.0 (which Applicant has admitted incorporates the claimed invention) was subject to public use prior to Applicant's critical date of December 12, 1999; therefore, claims 1-54 are rejected under 35 U.S.C. 102(b).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692